

REMARKS

Reconsideration is requested.

INTERVIEW SUMMARY

On or about February 17, 2006, a brief telephone interview, initiated by the undersigned, was conducted between Examiner Davetta W. Goins, and the undersigned attorney, Raymond W. Green, regarding this Application. In preparation for the interview, I first called Examiner Goins on or about February 15, and left a message stating that I wished to discuss the Application; and that if she were so inclined, it would be useful for Examiner Goins to consider MPEP Section 715.02 at page 700-254 and Section 715.07 at pages 700-259 to 700-260.

Examiner Goins called me back on or about February 17, 2006. I stated that the Office Action of January 10, 2006, appears to overlook three things:

- (1) As stated in MPEP Section 715.02 at page 700-254, it is sufficient for a Declaration under 37 CFR 1.131 to show completion of what the reference shows, before the effective date of the reference.
- (2) As stated in MPEP Section 715.07 at pages 700-259 to 700-260, dates in a Declaration under 37 CFR 1.131 may be recited in the Declaration, and need not be present on the documents attached as exhibits to the Declaration; and one need not disclose the actual dates (of conception and reduction to practice), but one "may merely allege that the acts referred to occurred prior to a specified date." In the present case, all three Declarations under 37 CFR 1.131 state that the activities relied on occurred, and the documents were made, "before January 28, 1999". (Examiner Goins stated that she agreed with these statements.)
- (3) The Gager reference on which Examiner Goins relies (U.S. Patent 6,222,442 B1), does not refer to a "respiration detector 40", but rather a "presence detector 40", even though Examiner Goins uses the phrase "respiration detector 40" about 20 times in the Office Action of January 10, 2006. (Examiner Goins stated that she would have to check the reference.)

Examiner Goins then stated that the Declarations under 37 CFR 1.131 did not establish diligence, and that they were therefore, in her view, deficient. I stated that because Applicants both conceived and reduced to practice before the effective date of the Gager reference, Applicants did not need to show diligence, because diligence on behalf of a party who is both

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first to conceive and first to reduce to practice is irrelevant and unnecessary. Examiner Goins stated that she would like to have authority for that proposition.

I also informed Examiner Goins that in Reexamination 90/006,690 (of the Miller U.S. Patent 6,130,614, of which Applicant had copied claims for purpose of interference), in the appeal by the patentee to the Board of Patent Appeals and Interferences, a docketing notice had been issued on January 24, 2006; and that because no oral hearing had been requested, a decision on the appeal may soon appear.

RESPONSE TO FINAL REJECTION

Reconsideration, withdrawal of the rejections, and allowance of all claims (possibly subject to an interference with Miller U.S. Patent 6,130,614), are respectfully requested.

In the event that the Examiner cannot see clear to allow the Application at this time, due to the continued existence of Miller U.S. Patent 6,130,614, withdrawal of the finality of the Office Action of January 10, 2006; withdrawal of the rejections based on Gager U.S. Patent 6,222,442 B1; and suspension of prosecution in this Application, pending the resolution of the current appeal of the rejection of all surviving claims of the Miller Patent, would appear to be appropriate.

Applicants presented three Declarations under 37 CFR 1.131 in November, 2003, for the purpose of antedating two references (including Gager U.S. Patent 6,222,442 B1) that were then applied to the pending claims. The Examiner again rejected the claims, based primarily on the Gager reference, in February, 2004. The Declarations were not criticized in any way at that time. Applicants requested reconsideration of the rejection in May, 2004. The Examiner has now repeated that February, 2004, rejection, addressing the Declarations for the first time.

The Examiner states (page 2, paragraph 1) that the Declarations are not effective to overcome the Gager reference, because the evidence is insufficient to establish conception of the invention prior to the effective date (March 29, 1999) of the Gager reference; and that "the dates as to 'when' the meetings, e-mails and/or faxes [referred to in the Declarations] were made are not found" (page 2, paragraph 2). The Examiner then applies various rejections to the claims, in each of which Gager is the primary reference (pages 3-25, paragraphs 3-6).

The Examiner's holding that the Declarations are not effective is traversed.

THE FACTS

Applicants' Claimed Invention

Applicants Daniel J. Mattson, Kerry S. Berland, and Kenneth C. Kunin filed the present Application on April 25, 2000, claiming priority of Provisional Application 60/131,189, filed April 26, 1999.

Applicants' claims vary in scope, but essentially call for (1) monitoring the trunk of a vehicle, by detecting the respiration¹ of a living person or animal in a closed trunk of a vehicle, detecting the operational condition of the vehicle, and opening the trunk in response to a predefined safe operational condition and detection of respiration in the trunk (Claim 1); (2) determining the respiration of a living person or animal in an enclosure by ventilating the enclosure, sensing a base line CO₂ concentration in the enclosure, closing the enclosure, sensing an increase in the CO₂ concentration in the enclosure, and providing a rescue operation in response to a detecting an increase in CO₂ concentration in the enclosure consistent with what would be produced by a living person or animal in the enclosure (Claim 16); (3) apparatus for sensing the presence of a person in the trunk of a vehicle, comprising a CO₂ sensor for detecting concentrations of CO₂ in the trunk and a microcontroller for comparing the concentrations of CO₂ in the trunk and generating an alarm under specified conditions (Claim 20); (4) determining the presence of a person in a closed trunk of a vehicle, by sensing concentrations of CO₂ in the trunk and generating an alarm under specified conditions (Claim 22); (5) controlling a vehicle having a trunk or other compartment that is opened and closed, by detecting the respiration of a living person or animal in the closed trunk or compartment, and opening the compartment or activating an alarm under specified conditions (Claims 27-29); (6) detecting an unsafe condition in the trunk of a vehicle, by detecting the respiration of a living person or animal in the closed trunk (Claim 30); (7) a detection system for use in a vehicle having a trunk that is opened and closed, comprising a breathing detector and a controller which opens the trunk upon the detection of breathing (Claim 31); (8) detecting a child in the trunk of a vehicle, by measuring the CO₂ in the trunk and using the amount of CO₂ to determine the presence of the child (Claim 40); and (9) an assembly for detecting an individual in a vehicle trunk, comprising a breathing sensor and a controller which provides a signal when breathing is detected (Claim 42).

¹ "Respiration" is *breathing*. It releases carbon dioxide (CO₂) into the atmosphere in which the respiration occurs.

The invention as claimed is supported by the Application filed April 25, 2000, and by the Provisional Application 60/131,189, filed April 26, 1999. Applicants therefore have an effective filing date and a constructive reduction to practice date of April 26, 1999.

The Applied Gager Reference

Gager et al. U.S. Patent 6,222,442B1 (“Gager”) issued April 24, 2001, based on an application filed March 29, 1999, about 4 weeks prior to Applicants’ effective filing date and constructive reduction to practice date of April 26, 1999. Gager discloses apparatus for detecting the presence of a person in a vehicle trunk compartment, and releasing the person so found, the detecting apparatus including a “*presence detector*” to detect *motion* in the vehicle trunk compartment (Gager Abstract, lines 1-4, emphasis supplied). Gager’s “presence detector” 40 may be a *motion sensor*, a *heat sensor* such as an infrared sensor, or a *sonic sensor* such as an ultrasonic sound sensor, or a combination of one or more of such sensors (Gager col. 2, lines 52-55). Gager does *not* teach or suggest the use of a “respiration detector”. The species of “presence detector” suggested by Gager are all subject to “false positive” detections. For example, a motion sensor might detect motion of a flexible inanimate object in a trunk, such as a tomato plant. A heat sensor might detect cooked food or hot coffee being transported in a trunk. An ultrasonic sound sensor might detect signals recorded on music played on a sound system located in the trunk. Gager acknowledges that it may be desirable to “tune” the sensors used “to exclude environmental interference”, Gager col. 2, lines 60-64.

Applicants’ Proofs

Applicants’ Declarations under 37 CFR 1.131 show the following:

1. Daniel J. Mattson, Kerry S. Berland, and Kenneth C. Kunin confirm that they consider themselves to be the inventors of this Application, and that they conceived the apparatus and system whereby the presence of a person trapped in the trunk of a vehicle can be detected by sensing either heat or motion of the person in the trunk, or by detecting the carbon dioxide (CO₂) released by a respiring person in the trunk. Declaration of Daniel J. Mattson, paragraphs 1 and 4; Declaration of Kerry S. Berland, paragraphs 1 and 4; Declaration of Kenneth C. Kunin, paragraphs 1 and 4.

2. Prior to January 28, 1999, inventors Daniel J. Mattson and Kenneth C. Kunin, and other employees of Cherry Corporation, met in a brainstorming session to discuss emergency trunk release systems that could employ various kinds of sensors to detect the presence of a person in the trunk of a vehicle, and release the sensed person by opening the trunk. Exhibit A to each of the Declarations shows materials that were used at the meeting. Exhibits B and C are notes taken during the meeting. Exhibit D is a sketch of a solenoid-activated trunk latch. Declaration of Daniel J. Mattson, paragraph 7; Declaration of Kerry S. Berland, paragraph 7; Declaration of Kenneth C. Kunin, paragraph 7.

3. Exhibit A shows conception of the problem (page 1), the existence of a prior art solution using a switch and relevant considerations (page 2), more relevant considerations (page 3), and an agenda for the discussion (pages 4-6).

4. Exhibit B shows conception of using an IR sensor or CO₂ sensor to detect the presence of a person in the trunk.

5. Exhibits C and D show conception of using a solenoid-activated trunk latch to automatically open the trunk when a person is detected inside.

6. Exhibit E shows conception of using a CO₂ sensor to detect the presence of a person in the trunk, and provides further details of how such a system might be built.

7. Exhibit F provides further details of how such a system might be built.

8. After the Cherry Corporation brainstorming session referred to above, but still before January 28, 1999, Cherry (acting in furtherance of the inventive concepts of Daniel J. Mattson and Kenneth C. Kunin) hired inventor Kerry S. Berland to assist in developing the emergency trunk release system. Exhibit G is a letter, still before January 28, 1999, from inventor Kerry S. Berland to inventor Daniel J. Mattson, summarizing some of the brainstorming discussions; including some of inventor Kerry S. Berland's own conceptions; and proposing a plan for reduction to practice. Declaration of Daniel J. Mattson, paragraph 8; Declaration of Kerry S. Berland, paragraph 8; Declaration of Kenneth C. Kunin, paragraph 8.

9. Exhibit G shows conception of five sensor technologies that can be used for an Emergency Exit Trunk Latch, namely IR, Capacitive, CO₂, Microwave and Ultrasonic sensors (see Exhibit G, page 1). Exhibit G further shows detailed plans for making Emergency Exit Trunk Latches using IR and Capacitive sensors (see Exhibit G, pages 2-4).

10. Inventor Kerry S. Berland and his employee Jeff Hunsinger built and successfully tested a prototype of the invention before January 28, 1999, using an infrared sensing apparatus. The work in building and testing the prototype is documented in a contemporaneous invoice which includes time entries all prior to January 28, 1999, a copy of which is Exhibit H. Declaration of Daniel J. Mattson, paragraphs 10 and 11; Declaration of Kerry S. Berland, paragraphs 10 and 11; Declaration of Kenneth C. Kunin, paragraphs 10 and 11.

11. Exhibit I is a circuit diagram of an interface for the infrared trunk occupancy sensor, prepared prior to January 28, 1999. Declaration of Daniel J. Mattson, paragraph 12; Declaration of Kerry S. Berland, paragraph 12; Declaration of Kenneth C. Kunin, paragraph 12.

12. The events reported in the Declarations and in Exhibits A-H occurred in the United States prior to January 28, 1999. The original documents, of which Exhibits A-I are copies, were all made prior to January 28, 1999. Declaration of Daniel J. Mattson, paragraphs 14 and 15; Declaration of Kerry S. Berland, paragraphs 14 and 15; Declaration of Kenneth C. Kunin, paragraphs 14 and 15.

THE LAW

The Relevant Statute and Treatises

35 USC 102(g)(2) provides that

“A person shall be entitled to a patent unless –

(g)(2) before such person’s invention thereof, the invention was made in this country by another inventor In determining priority of invention under this subsection [*i.e.*, ‘during the course of an interference conducted under section 135 or section 291’], there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.”

Thus, the Statute contemplates that the only diligence that is relevant is that by “*one who was first to conceive and last to reduce to practice*” – *i.e.*, in an interference, diligence by one who both conceived and reduced to practice before the effective date of another party is

unnecessary and irrelevant. This is stated *implicitly* in the Statute, but is spelled out *explicitly* in treatises.

Rivise and Caesar, *Interference Law and Practice*, Vol. I (1940), § 176, **Diligence of First Conceiver**, says at page 544:

It follows, therefore, that a party who was first both to conceive and reduce an invention to practice is not chargeable with diligence, and in the absence of special circumstances is entitled to an award of priority *irrespective of how much neglect or delay may have intervened between his dates of conception and reduction to practice*. (Emphasis in original.)

Rivise and Caesar goes on to discuss cases applying this rule at pages 544-48. A copy of pages 544-48 is enclosed (see Appendix, pages 14-19) for the Examiner's convenience.

3A D. Chisum, *Patents*, § 10.03[1] (2002) says at page 10-28:

[a] – Comparative Diligence. [35 USC] Section 102(g) directs that consideration be given only to “the reasonable diligence of one who was first to conceive and last to reduce to practice.” It has long been settled that priority does not involve a “race of diligence” or a comparison of the diligence of the parties. Thus, the diligence of the party who was either first or second to conceive but first to reduce to practice in achieving that reduction to practice is immaterial. ...

A copy of page 10-28 is enclosed (see Appendix, pages 20-21) for the Examiner's convenience.

The Relevant Regulation

37 CFR 1.131 provides that

“(a) When any claim of an application ... is rejected, the inventor of the subject matter of the rejected claim ... may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference ... on which the rejection is based. ...

“(b) The showing of facts shall be such, in character and weight, as to establish

[i] *reduction to practice prior to the effective date of the reference*, or

[ii] conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said [effective] date [of the reference] to a subsequent reduction to practice or to the filing of the application. ...” (emphasis, bracketed material and paragraphing provided).

Thus, practice under Rule 131 parallels that in an interference, by considering diligence only if one cannot show reduction to practice prior to the effective date of the reference.

The Relevant Sections of the MPEP and Reported Decisions

The Manual of Patent Examining Procedure, in Section 715.07, III² explains at page 700-260 that

“... 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

“(A) >(actual)< reduction to practice of the invention prior to the effective date of the reference; or

“(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

“(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).”

Thus, if one can show actual reduction to practice of “the invention” prior to the effective date of the reference, under a type “(A)” showing, diligence is not necessary. Case law supports this distinction:

A party who was both first to conceive and first to reduce to practice the invention of the Count is entitled to an award of priority, regardless of whether that party was diligent in reducing the invention to practice. *New Idea Farm Equip. Corp. v. Sperry Corp.*, 916 F.2d 1561, 1566-67, 16 USPQ2d 1424, 1428-29 (Fed. Cir. 1990).

MPEP Section 715.07, III does not say which invention, that of the reference or that of the applicant, needs to be reduced to practice prior to the effective date of the reference. MPEP Section 715.02 states, however, at page 700-254, that it is sufficient for a Declaration under 37 CFR 1.131 to show completion of what the reference shows, before the effective date of the reference. Case law supports this explanation:

“[W]here the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. *In re*

² All references herein to the MPEP are to the 8th edition, including any revisions through Rev. 3, August 2005.

Stryker, 435 F.2d 1340 [, 1341-42], 168 USPQ 372 [, 373] (CCPA 1971).” (Quotation from MPEP Section 715.02 at page 700-254, pinpoint citations provided.)

“If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit is sufficient, whether or not it is a showing of the identical disclosure of the reference See *In re Wakefield*, 422 F.2d 897 [, 901-02], 164 USPQ 636 [, 640] (CCPA 1970).” (Quotation from MPEP Section 715.02 at page 700-254, pinpoint citations provided.)

An inventor may antedate a reference by establishing completion of so much of his invention as is disclosed in the reference. *Application of Stempel*, 241 F.2d 755, 759, 113 USPQ 77, 81 (CCPA 1957) (“We are convinced that under the law all the applicant can be required to show [in order to antedate a reference under 37 CFR 1.131] is priority with respect to so much of the claimed invention as the references happens to show.”); *Application of Fong*, 288 F.2d 932, 936, 129 USPQ 264, 268 (CCPA 1961).

MPEP Section 715.07 states, at pages 700-259 to 700-260, that dates in a declaration under 37 CFR 1.131 may be recited in the declaration, and need not be present on the documents attached as exhibits to the declaration; and one need not disclose the actual dates (of conception and reduction to practice), but one “may merely allege that the acts referred to occurred prior to a specified date.”

CONCLUSIONS TO BE DRAWN

Applying the law to the facts established, it is to be concluded that Gager described a system in U.S. Patent 6,222,442B1, having an effective filing date of March 29, 1999, in which an occupant of a closed trunk is detected by a “presence detector” 40, which may be a motion sensor, a heat sensor such as an infrared sensor, or a sonic sensor such as an ultrasonic sound sensor, or a combination of one or more of such sensors (Gager col. 2, lines 52-55). Before March 29, 1999, however, and in fact before January 28, 1999 (the effective date of another reference, no longer applied in the present Application), inventors Daniel J. Mattson, Kerry S. Berland, and Kenneth C. Kunin conceived of such a system, using a sensor that could be an IR, capacitive, CO₂, microwave or ultrasonic sensor. Also before January 28, 1999, inventor Kerry S. Berland and his employee Jeff Hunsinger built and successfully tested a prototype of the

invention, using an infrared sensing apparatus. Thus, while Applicants have not shown reduction to practice of the device before January 28, 1999, in all the detail now claimed, including the use of respiration detectors, Applicants have shown conception and reduction to practice of as much of the Gager reference as is relevant to Applicants' invention, before Gager's effective date. That is all that the law requires.

Applicants have further presented Declarations under 37 CFR 1.131 by each inventor, supported by copies of original documents as Exhibits, to prove the prior conception and reduction to practice. The dates on the documents have been redacted, and the matter of dates is covered in the body of the Declarations, as is allowed. The actual dates have not been given, but they have been recited as "before January 28, 1999" or "prior to January 28, 1999", as is allowed.

In short, the Applicants have shown conception and reduction to practice, and therefore completion of the invention, of as much of the Gager reference as is relevant to Applicants' invention, before Gager's effective date. The rejection based on Gager should therefore be withdrawn.

RESPONSE TO CRITICISMS OF THE EXAMINER

The Examiner criticizes Applicants' Declarations under 37 CFR 1.131, saying (1) "The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of ... Gager" (Office Action of January 10, 2006, page 2, paragraph 2.) On the contrary, the evidence submitted shows conception of as much of the Gager reference as is relevant to Applicants' invention, before Gager's effective date. The evidence submitted also shows conception of the particular presence detector claimed by Applicants, namely the CO₂ detector, before Gager's effective date.

The Examiner next says (2) "Further, although documents suggesting that meetings about the trunk latching system are provided, the dates as to 'when' the meetings ... were made aren't found." (Office Action of January 10, 2006, page 2, paragraph 2.) On the contrary, the evidence submitted shows that the meetings and all activities relied on were before January 28, 1999.

The Examiner further said (3) that Applicants have not established diligence, and that the Declarations were therefore deficient. (Telephone Interview on or about February 17, 2006.) It

is true that Applicants have not established diligence, but it is erroneous to conclude that the Declarations were therefore deficient. Applicants have shown conception and reduction to practice of so much of the Gager reference as is relevant to Applicants' invention, prior to the effective date of the Gager reference. A showing of diligence by Applicants is therefore irrelevant and unnecessary.

Accordingly, it is respectfully submitted that *Applicants' Declarations under 37 CFR 1.131 have antedated the Gager reference*, and that *all rejections based primarily on Gager should therefore be withdrawn*.

RESPONSE TO SUBSTANTIVE REJECTIONS

All of Applicants' pending claims are rejected under 35 USC 103(a) as being unpatentable (obvious) over Gager in view of secondary references (Claims 1, 5-12, 14, 15 and 27-29, pages 3-8, Section 4 of Office Action of January 10, 2006; Claims 2-4, 16-26 and 30-43, pages 8-24, Section 5 of Office Action; Claim 13, pages 24-25, Section 6 of Office Action). Since all of these rejections rely on Gager as a primary reference, and since Applicants have antedated Gager under 37 CFR 1.131, **the rejections should all be withdrawn**.

With respect to the Examiner's analysis of the Gager reference, it is pointed out that although the Examiner refers to Gager's "respiration detector 40" about 20 times, **Gager does not disclose a "respiration detector"**, but rather a "presence" detector 40, which may be a *motion sensor*, a *heat sensor* such as an infrared sensor, or a *sonic sensor* such as an ultrasonic sound sensor, or a combination of one or more of such sensors (Gager col. 2, lines 52-55).

The Examiner erroneously states that "... Gager discloses a device used to detect the respiration of a 'person'" (Office Action, middle of page 9). Gager makes no such disclosure.

The Examiner correctly states that "... Gager does not disclose the claimed step of detecting the respiration of a person or animal ..." (Office Action, bottom of page 7); "... neither Gager nor Sonderegger specifically disclose the claimed step of detecting the respiration of a living person ..." (Office Action, bottom of page 8 and again near the bottom of page 9); that "... Gager does not disclose the claimed method of sensing a base line concentration of CO₂" (Office Action, page 12, lines 3-4); that "... Gager does not disclose the claimed CO₂ baseline

Appl. No. 09/558,386
Request for Reconsideration dated March 6, 2006
Response to Final Rejection dated January 10, 2006

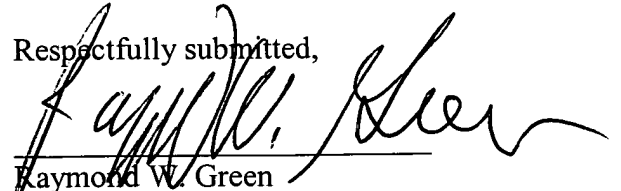
concentration [determination]" (Office Action, sentence bridging pages 14-15); that "... Gager does not disclose the claimed ... method providing an alarm when the respiration of the living person or animal is detected" (Office Action, bottom of page 16); that "... Gager does not disclose the claimed breathing detector ..." (Office Action, top of page 19); that "... Gager does not disclose the claimed carbon dioxide being emitted by the individual" (Office Action, bottom of page 19); that "... Gager does not disclose the claimed breathing detector measures the amount of carbon dioxide" (Office Action, page 16, lines 4-5); and that "... Gager does not disclose the claimed method of measuring an amount of carbon-dioxide within the trunk" (Office Action, near the bottom of page 23).

CONCLUSION

Reconsideration, acceptance of Applicants' Declarations under 37 CFR 1.131, withdrawal of the rejections based on Gager, and allowance of the Application (or an indication of allowability subject to a possible Interference with Miller), are courteously requested. Applicants' Declarations submitted in 2003 by all three inventors have shown conception and reduction to practice of as much of the invention as is shown by Gager, prior to January 28, 1999, and prior to the effective date of Gager. Applicants are not required to show diligence, because Applicants both conceived and reduced to practice, before the effective date of Gager. Applicants' Declarations meet the formal requirements set forth in the MPEP.

Accordingly, the outstanding rejections should be withdrawn, and the Application indicated to be allowable. Such action is courteously requested.

Respectfully submitted,


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INTERFERENCE LAW AND PRACTICE

VOLUME I

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WITH FORMS

THE MICHIE COMPANY, LAW PUBLISHERS
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1940

The following are the facts of the *Smith case*:

Pritchard and Smith were fellow employees. Pritchard conceived a corrugating machine and explained it to Smith. The machine was built according to Pritchard's plans, but Smith filed an application in his own name. Pritchard did not file his application until Smith's patent had been granted, but the decision was awarded to Pritchard on the ground that he was in fact the actual inventor.

§ 176. Diligence of First Conceiver.

The second principle is that the question of diligence is of importance only in the case of a party who was first to conceive the invention but who did not reduce it to practice until after his opponent had done so.

As was previously stated, priority of invention belongs to the party who was either the first both to conceive and reduce the invention to practice, or in lieu thereof, was the first to conceive the invention and was proceeding with reasonable diligence to a reduction to practice from a time just prior to the time his opponent entered the field up to the completion of his own reduction.³ It follows, therefore, that a party who was first both to conceive and reduce an invention to practice is not chargeable with diligence, and in the absence of special circumstances is entitled to an award of priority *irrespective of how much neglect or delay may have intervened between his dates of conception and reduction to practice*.

Henderson v. Gilpin, 39 App. D. C. 428; 1913 C. D. 310; 187 O. G. 231 (Appeals D. C. 1912), is directly in point. In this case, Henderson, the appellant, conceded for the purpose of argument that Gilpin was the first both to conceive and reduce the invention to practice, but contended that Gilpin had not been diligent prior to his reduction to practice. In dismissing this contention, the court stated:

"Appellant further contends that, even assuming Gilpin's priority of conception and reduction to practice, appellant is

³. See Section 173.

nevertheless entitled to be considered the prior inventor because, as he says, Gilpin was guilty of laches, while he was diligent. This point is not well taken. Prior to the act of 1836, he who first reduced to practice was, in the eyes of the law, the prior inventor. The act of 1836, now sec. 4920, Rev. Stat., U. S. Comp. Stat. 1901, p. 3394, permitted one 'who was using reasonable diligence in adapting and perfecting' his invention to prove priority, notwithstanding his opponent has been the first to reduce to practice. In this case, however, Gilpin was the first to conceive and the first to perfect his invention. In those circumstances, he is entitled to the invention unless he abandoned it to the public or secreted and suppressed it for such a period as to forfeit his rights to another."

To the same effect are each of the following cases:

- Hubbard v. Berg*, 40 App. D. C. 577; 1913 C. D. 460; 195 O. G. 818 (Appeals D. C. 1913).
Stewart v. Thomas, 42 App. D. C. 222; 1914 C. D. 180; 202 O. G. 1263 (Appeals D. C. 1914).
Gammeter v. Thropp, 42 App. D. C. 564; 1915 C. D. 59; 210 O. G. 1397 (Appeals D. C. 1914).
Townsend v. Smith, 17 C. C. P. A. 647; 1930 C. D. 63; 391 O. G. 753; 36 Fed. Rep. (2nd) 292; 4 U. S. Pat. Q. 269.
Brydle v. Honigbaum, 19 C. C. P. A. 773; 1932 C. D. 102; 415 O. G. 755; 54 Fed. Rep. (2nd) 147; 11 U. S. Pat. Q. 219.
Brogden et al. v. Henry, 21 C. C. P. A. 1043; 1934 C. D. 419; 447 O. G. 8; 69 Fed. Rep. (2nd) 978; 21 U. S. Pat. Q. 279.
Kyrides v. Bruson, 26 C. C. P. A. 986, 1939 C. D. ; 506 O. G. 6; 102 Fed. Rep. (2nd) 416; 41 U. S. Pat. Q. 107.

It also follows that a party who was first to conceive but second to reduce the invention to practice cannot avail himself of an alleged lack of diligence on the part of his opponent. In other words, the diligence or lack of diligence of the party first to reduce is wholly immaterial.

The following are the facts of *Paul v. Johnson*, 23 App. D. C. 187; 1904 C. D. 610; 109 O. G. 807 (Appeals D. C. 1904):

Paul was the first to conceive the invention while Johnson was the first to reduce it to practice. The testimony showed

that Paul had not been diligent when Johnson entered the field, but Paul contended that he should, nevertheless, prevail for the reason that Johnson had also been lacking in diligence and that Paul had become active while Johnson was still inactive.

The court overruled Paul's contention with the statement that no lack of diligence can be imputed to the party who is first to reduce an invention to practice, since he was first to give the invention to the public. The court went on to state:

"The principle is well and clearly stated by Judge Taft, in delivering the opinion of the Circuit Court of Appeals of the sixth circuit, in the case of *Christie v. Seybold*, 5 C. C. A. 36; 6 U. S. App. 520; 55 Fed. 69. In that case the judge said:

"The diligence of the first reducer to practice is necessarily immaterial. It is not a race of diligence between two inventors in the sense that the right to the patent is to be determined by comparing the diligence of the two, because the first reducer to practice, no matter what his diligence or want of it, is prior in right, unless the first conceiver was using reasonable diligence at the time of the second conception and the first reduction to practice."

A similar result on substantially the same set of facts was reached in *Grabowsky v. Gallaher*, 39 App. D. C. 548; 1913 C. D. 415; 191 O. G. 835 (Appeals D. C. 1913).

It further follows that an inventor who was not the first to conceive cannot urge his own diligence as a ground for an award of priority. To quote from *Bickhart v. Crissey*, 55 App. D. C. 18; 1924 D. C. 330; 328 O. G. 254; 299 Fed. Rep. 703 (Appeals D. C. 1924):

"the later to conceive does not succeed by reason of his own swiftness, but only by reason of the idling by the wayside of him who started first."

What has been said does not necessarily mean that in determining whether a party has been reasonably diligent in securing a reduction to practice, it is improper to compare his conduct with that of his opponent.

The following are the facts of *Stapleton v. Kinney*, 18 App.

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D. C. 394; 1901 C. D. 414; 96 O. G. 1432 (Appeals D. C. 1901):

The invention in issue was an automobile tire. Stapleton sought to explain a long delay in reducing the invention to practice by urging that he had been endeavoring to devise a simple device for readily applying the tire to the wheel. Since the utility and commercial value of the tire did not necessarily depend upon the device for applying the tire, the court held that Stapleton had not exercised reasonable diligence.

In its decision, the court stated:

"Considering the special circumstances of the case at bar, we are of the opinion that Stapleton's efforts to invent machinery for the simpler, cheaper, and more effective application of the improved tire, cannot be accepted as due diligence in completing its invention. Grant that some measure of indulgence might justly be extended him, under ordinary circumstances, in respect of the matter of actual construction and test of commercial value, yet, the well-known conditions of the art and the wide-extended trade in rubber tires, subject to similar difficulty and expense in application, made it incumbent upon him to, at least, seek constructive reduction by filing an application for a patent. Why he did not do this much remains unexplained. *His conduct in both respects is in marked contrast with that of Kinney who conceived the invention in October, 1898, filed his application for patent in January, 1899, and commenced manufacture for the trade in the following April.*" (Italics added.)

According to *Cragg v. Strickland*, 47 App. D. C. 433; 1918 C. D. 163; 250 O. G. 255 (Appeals D. C. 1918), the fact that it took longer for the party chargeable with diligence to reduce the invention to practice than it did his opponent does not necessarily mean that the party was not reasonably diligent.

To quote from the decision:

"There is no doubt that Strickland was the first to conceive the invention, and, while it is true that work on an independent device does not constitute diligence, *it does not necessarily follow that because one applicant has completed his invention in a given time the other will be charged with*

a lack of diligence if he exceeds that time in perfecting his embodiment of the invention. Where the claim is general, as here, one embodiment may be more complicated than another. Certainly we are not prepared to say, under the evidence before us, that Strickland was not proceeding in good faith to complete his embodiment when Cragg entered the field, nor do we find him lacking in reasonable diligence from that time until the filing of his claim a few months later." (Italics added.)

§ 177. Simultaneous Reductions to Practice.

The third principle is that the question of diligence does not arise in cases of simultaneous reductions to practice.

The following are the facts in *McParland v. Beall*, 45 App. D. C. 162; 1916 C. D. 231; 231 O. G. 605 (Appeals D. C. 1916):

McParland and Beall filed their patent applications on the same day. The Patent Office awarded priority of invention to Beall because he proved that he had been the first to conceive the invention. McParland contended that since both applications were filed the same day, if it appeared that Beall, though the first to conceive, was not diligent when McParland entered the field, he was not entitled to an award of priority.

In affirming the Patent Office decision, the court stated:

"The first to reduce to practice is *prima facie* the inventor. *Paul v. Johnson*, 23 App. D. C. 187. It follows that the party last to reduce to practice may overcome the prior party only by proving that he was the first to conceive the invention, and that he was exercising due diligence when the prior party entered the field. In *Furman v. Dean*, 24 App. D. C. 277, the rule is well stated as follows: 'As Dean, the appellee, was the first to come into the Patent Office, he must be held to have been the first to reduce the invention to practice; and it only remains to inquire whether he was also the first to conceive and disclose the invention. For if he was, all other questions are precluded.'

"In the present case, the Commissioner of Patents held that 'where both parties reduce at the same time he who first conceived the invention must be regarded as the first inventor'. This must be so, since only the party last to reduce

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§ 10.03[1][a]

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In determining priority of invention, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Thus, assuming diligence on the part of the applicant, it is normally the first inventor to conceive, rather than the first to reduce to practice, who establishes the right to the patent.

It is well settled that an invention may be patented before it is reduced to practice.¹⁴

It should be emphasized that the priority rules operate as between independent and original inventors. One who derives the conception of an invention from another is not an original inventor and may not obtain a valid patent.¹⁵

Aspects of the basic rule and diligence exception are discussed and illustrated below. The meaning of conception, actual reduction to practice, constructive reduction to practice, and diligence are discussed in following sections.

[a]—Comparative Diligence. Section 102(g) directs that consideration be given only to "the reasonable diligence of one who was first to conceive and last to reduce to practice."¹⁶ It has long been settled that priority does not involve a "race of diligence" or a comparison of the diligence of the parties.¹⁷ Thus, the diligence of the party who was either first or second to conceive but first to reduce to practice in achieving that reduction to practice is immaterial. Further, the lack of diligence of the first to reduce to practice in seeking a patent after

14 525 U.S. at 60-61, 48 USPQ2d at 1644.

15 See Chapter 2 and § 10.04[4]. See also *Howard v. Jenkins*, 202 USPQ 774, 781 (Bd. Pat. Int'l. 1977) ("diligence of the party from whom the invention was derived is immaterial"); *McLean v. Osborne*, 201 USPQ 534, 538 (Bd. Pat. Int'l. 1976) ("In view of our finding that Osborne derived the information from Dr. McLean, whether [McLean's assignee] suppressed and concealed the invention within the meaning of 35 U.S.C. 102(g) during that period is not in issue.");

16 35 U.S.C. § 102(g).

17 E.g., *Steinberg v. Seitz*, 517 F.2d 1359, 1364, 186 USPQ 209, 213 (CCPA 1975) (diligence "is of importance only when the party who is first to conceive does not reduce his invention to practice until after the other party has done so"); *Henning v. Hunt*, 223 F.2d 926, 942, 106 USPQ 807 (CCPA 1955); *Kyrides v. Branson*, 102 F.2d 416, 420, 41 USPQ 407 (CCPA 1939); *Brogden v. Henry*, 69 F.2d 978, 981, 21 USPQ 279 (CCPA 1934); *Townsend v. Smith*, 36 F.2d 292, 296, 4 USPQ 269 (CCPA 1929).

See also *Christie v. Seybold*, 55 F.3d 69 (6th Cir. 1893), discussed at § 10.02[3](b); *Maxwell v. J. Baker, Inc.*, 805 F. Supp. 735, 738, 26 USPQ2d 1241, 1248 (D. Minn. 1992), *vacated in part*, 820 F. Supp. 444, 27 USPQ2d 1628 (D. Minn. 1993), *rev'd*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996), *cert. denied*, 520 U.S. 1115 (1997) ("a patent holder must not only be the first to conceive the invention, but also the first to reduce it to practice."); *Nashef v. Pollock*, 4 USPQ2d 1631, 1635 (Bd. Pat. App. & Int'l. 1987).

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